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REMARKS

By way of the present response, claims 1, 2, 7, 8, 14, 15, 21, 22, 26, 27, 31, 32 and 36 are amended, and claims 25, 30 and 35 are canceled. Claims 1-24, 26-29, 31-34 and 36 currently are pending. Reconsideration and withdrawal of the rejections of the claims is respectfully requested.

Claim 2 is amended to explicitly recite that the device is a peripheral device, which has antecedent basis in the recitation "a peripheral device" in lines 3, 5 and 7 of claim 1. Claims 1, and 8 are amended to recite that the processes of monitoring and submitting are performed by the peripheral device, and claim 15 is amended to recite that the monitoring and ordering systems are included with the peripheral device. Support for the amendments to claims 1, 8 and 15 is found in at least in paragraph 20 of the specification, for example. Claims 22, 27 and 32 are amended to incorporate the features of now canceled claims 25, 30 and 35, respectively. The dependencies of claims 26, 31 and 36 are changed in light of the respective amendments to claims 22, 27 and 32, and the cancellation of claims 25, 30 and 35. The amendments to claims 7, 14 and 21 are discussed below.

The most recent office action includes rejections of claims 1-3, 8-10 and 15-17 under 35 U.S.C. § 103 as being unpatentable over Haines et al. (U.S. Patent Application Publication No. 2002/0072998, hereinafter "Haines '998") in view of Haines et al. (U.S. Patent Publication No. 2003/0074268, hereinafter "Haines '268"); rejections of claims 4, 11 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Haines '998 and Haines '268, and in further view of official notice; rejections of claims 5, 6, 12, 13, 19, 20, 22-24, 27-29 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Haines '998 and Haines '268, in further view of Bezos (U.S. Patent No. 6,029,141); rejections of claims 25, 30 and 35 as being unpatentable over Haines '998, Haines '268 and Bezos, in further view official notice; rejections of claims 1-6, 8-13, 15-20, 22-24, 27-29 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Hayward et al. (U.S. Patent No. 6,629,134)¹ in view of Haines '268;

¹ On page 16 of the action, under the heading "Claims 27-30 (Hayward as primary reference)," the ground of rejection cites the Haines '998 and Haines '268 documents. It is believed this is a typographical error and that the Examiner intended to cite the Hayward et al. patent instead of Haines '998.

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and rejections of claims 25, 30, and 35 under 35 U.S.C. § 103(a) over Hayward et al. in view of Haines '268, and further in view of official notice².

It is respectfully submitted that the Haines '998, Haines '268, and Bezos, Hayward et al. documents, and the Official Notices taken, whether considered individually or in any combination, fail to teach or suggest the presently recited combinations including the features of "monitoring for an input indicating that an order for the at least one of the consumables has been placed ... in response to receiving said input, submitting the order for the at least one of the consumable to a supplier if the monitored input indicates an order should be placed, wherein said monitoring and submitting are performed by the peripheral device," as recited in amended claims 1 and 8, and a system comprising "a monitoring system included with the peripheral device that monitors for an input indicating that an order for the at least one of the consumables has been placed ... an ordering system included with the peripheral device that submits, in response to receiving said input, the order for the at least one of the consumables to a supplier if the monitored input indicates an order should be placed," as recited in amended claim 15. Additionally, none of Haines '998, Haines '268, and Bezos, Hayward et al. and the official notice taken, whether considered individually or in any combination, teaches or suggests the combinations of features of "processing the order for the at least one consumable, wherein the processing comprises retrieving information about the peripheral device that placed the order ... wherein the retrieved information identifies a retailer that sold the peripheral device," as recited in amended claims 22 and 27, and the features of "a processing system that processes the order for the at least one consumable, wherein the order processing system retrieves information about the peripheral device that placed the order including the identification a retailer that sold the peripheral device," as recited in claim 32.

In connection with claims 1, 8 and 15, the Office acknowledges that the Haines et al. '998 publication does not disclose the features of a peripheral device performing processes of "monitoring for an input indicating that an order ... has been placed ..." and "submitting the order for the at least one consumable ...," but also asserts, "the claimed

² See footnote 1 with respect to claim 30. Similarly, the stated rejection of claim 35 cites the Haines '998 publication under the heading "Claims 32-35 (Hayward as primary reference), but not the Hayward et al. patent. It is assumed the Examiner intended to cite Hayward et al. instead of Haines '998.

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phrase 'with the peripheral device' is sufficiently broad that Haines '998's involvement of the peripheral device in the system meets the claim limitations." (See, page 3, lines 11-15.)

While applicants disagree with this overly broad interpretation of this phrase, especially when considering the context in which "with" is used (i.e., by way of, e.g., "eating with a fork") and in light of the Applicants' disclosure, claims 1, 8 and 15 are amended to make it abundantly clear that the processes of monitoring and submitting are performed by the peripheral device. The Office next asserts that "Haines '268 teaches the peripheral device submitting the order (Abstract; paragraph 8, claim 1), and teaches configuring the peripheral device and coordination of orders over a group of peripherals over time (paragraphs 54 and 55)." However, it is respectfully submitted that the Haines '268 publication does not operate to monitor for an input indicating that an order for the at least one of the consumables has been placed, much less submitting an order for the consumable in response to received input, as claimed. Rather, the peripheral device described in Haines '268 includes sensors that sense whether consumables have decreased below a predetermined threshold amount, and an embedded Web server that enables it to exchange information with a vendor website. With reference to Figure 7, and noting that the Haines et al. '268 publication does not provide a description of this figure, it appears that the method and system of Haines et al. '268 involves a peripheral device detecting the status of consumables (step 61), collating the status and identifier (of the peripheral device?) (step 62), and sends an electronic message (e-mail?) to someone (a purchaser or maintainer?) (step 63). The maintainer or purchaser sets thresholds in the vendor website for replenishment of consumables, and the peripheral device is configured with these thresholds (see, paragraphs 48, 49, 51 and 64-70). There is simply no description, implication, teaching or suggestion in Haines et al. '268 that the peripheral device monitors for input indicating that an order has been placed, as claimed.

Furthermore, the paragraphs 54 and 55 of Haines et al. '268 cited on page 3 of the office action do not teach or suggest that a peripheral device performs monitoring for input indicating that an order for at least one consumable has been placed. For instance, paragraph 54 describes a plug-in that may be provided in a host computer's browser application that takes configuration data from the vendor web site and configures a peripheral device. Paragraph 55 describes that a maintainer may want to pool consumable orders or coordinate maintenance of local stocks of consumables. Thus, while it appears that the configured peripheral device in Haines et al. method and system may initiate an order based

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on comparing a sensed value to a value previously stored during a configuration process, there is no mention in Haines '268 that the peripheral device monitors for an input indicating that an order for at least one consumable has been placed. Therefore, Haines et al. '268 does not remedy the acknowledged deficiencies of the Haines et al. '998 publication with respect to a process of "monitoring for an input indicating that an order for the at least one of the consumables has been placed ...," as recited independent claims 1 and 8, and "a monitoring system included with the peripheral device that monitors for an input indicating that an order for the at least one of the consumables has been placed ...," as recited independent claim 15.

Turning now to amended independent claims 22, 27 and 35, which now respectively incorporate the features of dependent claims 25, 30 and 35, the Office takes Official Notice, at page 9, that it is allegedly well known to maintain and retrieve records of which dealer sold a device. The Office then concludes that it would have been obvious to one of ordinary skill in the art "for the retrieved information to identify a retailer that sold the device, for such advantages as determining what advertising had been effective, who was responsible for repairing or replacing device under warranty etc." This contention by the Office is respectfully traversed.

Before proceeding with an analysis of these rejections, it is to be noted that the Office asserts, incorrectly, that the Official Notice was not traversed by Applicants (see, page 19, lines 12-14). To the contrary, Applicants traversed this notice in Applicants' August 8, 2005, response, at page 12, and in the response submitted on December 12, 2005, at page 12. Applicants pointed out in these responses that the unsubstantiated assertions by the Office are too general and beyond the scope of that which is claimed. As a result, there is no motivation for modifying the within the specifically claimed context of processing an order for at least one consumable for a peripheral device.

Additionally, Applicants direct the Examiner's attention to MPEP § 2143, which instructs that to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references or references when combined must teach all the claim limitations.

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The motivation provided in the office action, "to identify a retailer that sold the device, for such advantages as determining what advertising had been effective, who was responsible for repairing or replacing device under warrantee etc.," is not supported by objective evidence of record. Such bald statements regarding motivation cannot constitute a proper basis for establishing a *prima facie* case of obviousness. Furthermore, why, after all the configuration processes involved with setting up the method and system of Haines et al. '268, would one of ordinary skill in the art be compelled to gather information about a retailer that sold the peripheral device during the processing of an order, especially when considering that the Haines et al. '268 system appears to involve repeating transactions for a device already known to the vendor? It is respectfully submitted, in the view of the lack of objective reasoning for the proposed combination in the office action, that the answer lies in the Office falling into hindsight reasoning, in which Applicants' invention is used as a road map for such a combination. Hindsight reasoning, of course, is impermissible. For at least these reasons, Applicants respectfully submit that the rejections under 35 U.S.C. § 103 are improper with respect to claims 22, 27 and 35. Accordingly, these rejections should be withdrawn.

Claims 2-5, 9-13, 16-20, 23, 24, 28-29, and 33-34 depend from one of claims 1, 8, 15, 21, 27 and 32, and are therefore allowable at least for the above reasons, and further for the additional subject matter recited.

Finally, with respect to claims 7, 14 and 21, Applicants have rewritten these claims in independent form so as to include all the limitations of the original independent claims and any intervening originally filed claims. As the Office pointed out on pages 18-19 of the February 8, 2005, office action, claims 7, 14 and 21, as presently amended, recite allowable subject matter not taught or suggested by the Hayward et al., Haines '998 and Bezos documents. Additionally, Applicants respectfully submit that no combination of the Hayward et al., Haines '998, Bezos and Haines et al. '268 documents, and the present allegations of what was allegedly well known in the art, whether considered individually or in combination, would have taught or suggested the combinations of features set in amended claims 7, 14 and 21.

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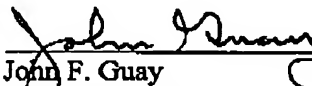
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In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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